

REMARKS

The Office Action of May 26, 2004 has been reviewed and the Examiner's comments carefully considered. The present Amendment amends claims 15, 20 and 23 in accordance with the originally-filed specification and cancels claim 19. Claims 1-18 and 20-39 remain in this application.

Initially, it is noted that the Examiner has placed on file a copy of the International Preliminary Examination Report (IPER), which was submitted in an Information Disclosure Statement, filed October 17, 2003. Applicant thanks the Examiner for placing the IPER on file and notes that this was only given to the Examiner as a courtesy for use and possible consideration during the prosecution of the present application. In addition, the Examiner is thanked for indicating that the subject matter of claims 22-25 and 31-36 defines over the prior art of record. Specifically, the Examiner indicated that claims 22, 24, 25 and 31-36 are objected to, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Further, claim 23 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph, set forth in the Office Action.

Claims 15, 19 and 23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With respect to the Section 112 rejections of claims 15, 19 and 23, Applicant submits that the above amendments to these claims and cancellation of claim 19 obviate these rejections. Further, the Examiner has objected to claim 20 under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 19, as the only difference between the two claims is that claim 19 uses the phrase "the number of times" and claim 20 uses the phrase "frequency", which the Examiner believes is substantially duplicative. Claim 19 has been cancelled by the foregoing amendment. In addition, the Section 112 rejection of claim 19 has been considered with reference to pending claim 20, and claim 20 has been appropriately modified. Therefore, the Examiner's rejections and objections to claims 15, 19, 20 and 23 have been addressed and overcome by the foregoing Amendment, and Applicant respectfully requests withdrawal of the same.

The Examiner has rejected claims 1, 2, 10-21, 26-29 and 37-39 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,615,209 to Gomes et al. (hereinafter "the Gomes patent"). Further, claims 3-7 and 30 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Gomes patent in view of U.S. Patent No. 6,240,409 to Aiken. Finally, claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Gomes patent in view of U.S. Patent No. 6,356,633 to Armstrong. In view of the attached Declaration, as discussed in detail hereinafter, and the following remarks, Applicant respectfully requests reconsideration of these rejections.

The Gomes patent has been used as the primary reference in all of the rejections by the Examiner. It is noted that the Gomes patent was issued on September 2, 2003 and is based upon an application (09/684,542), filed on October 6, 2000. This application was, in turn, based upon a provisional patent application (60/184,126), filed on February 22, 2000. Accordingly, the earliest filing date obtainable for the invention disclosed in the Gomes patent is February 22, 2000.

Attached hereto and incorporated herein by reference is a *Declaration Under 37 C.F.R. § 1.131 Showing Conception And Diligence Prior To February 22, 2000 Until November 15, 2000*, executed by Mr. Mark Kantrowitz (hereinafter "the *Kantrowitz Declaration*"). Mr. Kantrowitz is the named inventor of the invention described and claimed in the present application. *Kantrowitz Declaration* ¶ 1. The assignee for this application is Justsystem Corporation, and this application was filed in the United States Patent and Trademark Office on November 15, 2000. *Kantrowitz Declaration* ¶¶ 2 and 6.

On or about May 28, 1999, Mr. Kantrowitz authored a Progress Report describing the invention. In particular, in this Report, Mr. Kantrowitz wrote:

"The idea is to look for sequences of consecutive low-DF terms (DF = number of documents containing the term), allowing it to skip over certain extremely high-DF terms (like "of"). This seems to work very well."

This Progress Report was mentioned as the "First Disclosure (Oral or Written) of Invention" Section in an Invention Disclosure Record, dated June 24, 1999. *Kantrowitz Declaration* ¶¶ 3 and 4. A copy of the Invention Disclosure Record is attached as Exhibit 1 to the enclosed

Declaration.

Between the date of conception in May 1999 through the submission of an official Invention Disclosure Record and until the November 15, 2000 filing date of the present application, Mr. Kantrowitz worked with employees of Justsystem, as well as outside patent counsel, namely The Webb Law Firm, in diligently reducing the invention to practice and filing a patent application thereon. In particular, Mr. Kantrowitz presented and explained the invention to Justsystem employees for acceptance and review, developed and began implementing the invention, explained the invention to Justsystem's patent counsel, The Webb Law Firm, and reviewed the patent application prepared by patent counsel for filing. *Kantrowitz Declaration* ¶ 5. See also supporting documentation and correspondence between patent counsel and Justsystem employees evidencing the exchange of information, Exhibit 2 to the *Kantrowitz Declaration*.

The application was filed in the United States Patent and Trademark Office on November 15, 2000, and Mr. Kantrowitz declares that this invention was not sold or in public use in the United States for one year prior to the date of the above application, nor was it patented or described in a printed publication anywhere prior to that time. In addition, the invention was never abandoned. *Kantrowitz Declaration* ¶¶ 6 and 7. Therefore, this activity prior to the February 22, 2000 priority date of the application underlying the Gomes patent until November 15, 2000, which is the effective filing date of the United States patent application, demonstrates the required evidence of conception and diligence from before February 22, 2000 until November 15, 2000. *Kantrowitz Declaration* ¶ 8.

Accordingly, the invention underlying the present application was conceived prior to the filing of the provisional patent application underlying the Gomes patent (February 22, 2000), and the present invention was diligently reduced to practice through the November 15, 2000 filing date of the present application. Therefore, the Gomes patent does not represent prior art and should be withdrawn from consideration.

In the present application, claims 1, 37 and 39 are in independent form. Further,

with the withdrawal of the Gomes patent as a prior art reference to the present invention, independent claims 1, 37 and 39 are not anticipated by or rendered obvious over the Aiken patent, the Armstrong patent or any of the other prior art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claims 1, 37 and 39 is respectfully requested.

Claims 2-18 and 20-36 depend either directly or indirectly from and add further limitations to independent claim 1 and are believed to be allowable for the reasons discussed hereinabove in connection with independent claim 1. Further, claim 38 depends directly from independent claim 37 and is believed to be allowable for the reasons discussed hereinabove in connection with independent claim 37. Therefore, for all these reasons, reconsideration of the rejection of claims 2-18, 20-36 and 38 is respectfully requested.

For all the foregoing reasons, Applicant believes that claims 1-18 and 20-39, as amended, are patentable over the cited prior art and in condition for allowance. Reconsideration of the rejections and allowance of all pending claims 1-18 and 20-39 are respectfully requested.

Respectfully submitted,

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